

REMARKS

Claims 20-23 have been canceled. Applicants reserve the right to file one or more continuation or divisional applications directed to the canceled subject matter. New claim 25 has been added. New claim 25 corresponds to canceled claim 20 and finds basis in the specification in paragraph [0040] for example. No new matter is added.

Applicants acknowledge the receipt of the petition for acceptance of color drawings and appreciate the Office's effort to retrieve the color drawings from the storage facility.

Claim 23 is objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Office states that Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in independent form. The Office further states that Claim 22 recites "A vector comprising SEQ ID NO:6" and Claim 23 is directed to the vector of claim 22 wherein the fluorescent protein gene, encoding EGFP, is substituted by another fluorescent protein gene. The Office further states that if the gene encoding EGFP is removed from the vector of claim 22, the vector can no longer comprise SEQ ID NO 6 and claim 23 is directed to a vector that does not fall within the scope of claim

22.

Applicants respectfully submit that claim 23 has been canceled and new claim 25 is not of similar scope. Withdrawal of the instant rejection is respectfully requested.

The rejection of claims 20 and 21 under 35 USC 112, first paragraph, as failing to comply with the written description requirement is respectfully traversed. The Office states that the claim(s) contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Office states that claim 20 is directed to a vector "comprising a nucleotide sequence from a piggyBac transposon and at least one sequence encoding a fluorescent protein wherein said sequence encoding a fluorescent protein is operatively linked to a polyubiquitin promoter obtained from *Drosophila melanogaster*". The Office states that there is no literal or inherent support for the broad genus of vectors as recited in the rejected claims where the vector comprises "a" nucleotide sequence from a piggyBac transposon. As written, the claim reads on a vector comprising literally any dinucleotide sequence found in a piggyBac transposon sequence so long as it also comprises a sequence encoding a fluorescent protein operatively linked to the polyubiquitin promoter. The Office

states that this results in the claim reading on an enormous genus of vectors for which there is no literal support in the instant specification. The Office then states that for example, original claim 1 at least recites that the sequence encoding the fluorescent protein is inserted into the piggyBac sequence. The Office concludes that claims 20-21 are rejected from comprising impermissible new matter.

Applicants respectfully submit that new claim 25, which corresponds to canceled claim 20, no longer contains new matter as set forth in the above rejection. Withdrawal of the rejection is respectfully submitted.

The rejection of claim 22 under 35 USC 112, first paragraph as failing to comply with the written description requirement is respectfully traversed. The Office states that the claim contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Office states that the specification teaches that SEQ ID NO 6 describes a plasmid pB[Pub-nls-EGFP]#257. The Office states that there appears to be no literal or inherent support in the originally filed claims or specification for a vector "comprising" SEQ ID NO 6 or pB[Pub-nls-EGFP]#257. The Office concludes that claim 22 is rejected as comprising impermissible

new matter.

Applicants respectfully submit that claim 22 has been canceled. Withdrawal of the instant rejection is respectfully requested.

The provisional rejection of claims 20-24, as it now pertains to previously presented claim 24 and new claim 25, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/101,840 is respectfully traversed.

Applicants respectfully submit that a Terminal Disclaimer is attached to this response. Withdrawal of the instant provisional rejection is respectfully requested.

The rejection of claims 20-24, as it now pertains to previously present claim 24 and new claim 25, under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,733,914 is respectfully traversed.

Applicants submit that a Terminal Disclaimer is attached to this response. Withdrawal of the instant rejection is respectfully requested.

It is believed that all of the claims are in condition for allowance. Accordingly, it is respectfully requested that the instant application be allowed to issue. If any issues remain to be resolved, the Examiner is invited to telephone the

undersigned at the number below.

In the event this paper is deemed not timely filed, the undersigned hereby petitions for an appropriate extension of time. Please charge any fees, which may be required by this paper or at any time during prosecution of the instant application, or credit any overpayment, to deposit account 50-2134.

Respectfully submitted,

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DATE

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CERTIFICATE OF FILING VIA FACSIMILE

The undersigned hereby certifies that the attached **AMENDMENT AFTER FINAL REJECTION, TERMINAL DISCLAIMERS (2), NOTICE OF APPEAL AND PETITION FOR A ONE (1) MONTH EXTENTION OF TIME** was this day, February 3, 2005, filed in the United States Patent and Trademark Office via facsimile to facsimile number 571-273-8300. Total pages: 15

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